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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HOSSAIN, TANIM M

ART UNIT PAPER NUMBER

2141

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,021

Applicant(s)

GOLDSCHNEIDER ET AL.

Examiner

Tanim Hossain

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/05/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Detailed Action

Specification

1. The disclosure is objected to because of the following informalities:
 - a. In the Brief Description of the Drawings, describing figure 9, “shoes” is a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 6, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuisz (U.S. 6,389,455).
 - a. As per claim 1, Fuisz teaches a method for providing electronic mail (e-mail) management service comprising:

Providing a user with a distribution address that the user uses to distribute to at least one of persons and entities that the user desires to have contact with (column 1, lines 39-41, 58-60);

Setting up at least one of persons and entities address in a list that the user desires to have contact with (column 4, lines 45-47, 50-51);

Setting up a forwarding address that is associated with at least one of persons and entities address on the list (column 3, lines 59-61);

Receiving e-mail with a source address (column 1, lines 41-43);

Comparing the source address with the list that the user desires to have contact with (column 5, lines 51-53);

And retrieving a forwarding address and forwarding the e-mail if the source address matches the at least one of persons and entities address in a list (column 5, lines 53-54).

b. As per claim 6, Fuisz discloses a method for providing electronic mail (e-mail) management service comprising:

Providing a user with an access to a server (column 1, line 57; column 10, lines 40-41);

The rest of the components of claim 6 are rejected on the same basis as claim 1, as claim 6 describes a method of implementing claim 1.

c. Claim 11 is rejected on the same basis as claims 1 and 6, as claim 11 describes an apparatus for the implementation of claim 1.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4, 7-9, and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuisz in view of McCormick (U.S. 6,023,723).

a. As per claim 2, Fuisz teaches the method as in claim 1, but does not specifically teach storing at least one of the source address and the e-mail in a storage area if the source address does not match at least one of the persons and entities electronic address in the list. McCormick teaches this limitation (column 2, lines 49-51, where the "Waiting Room" is the storage area). It would have been obvious to one of ordinary skill in the art at the time of the invention to redirect electronic mail not corresponding to a filter list to a storage area, as taught by Fuisz in the system of McCormick, because both Fuisz and McCormick are from the same field of endeavor of e-mail filtering and organization. McCormick's teaching would further extend Fuisz's invention.

b. As per claim 3, Fuisz, in view of McCormick, discloses the method as in claim 2, further comprising allowing the user to review at least one of the source address and the e-mail stored in the storage area; and allowing the user to retrieve at least one of the source address and the e-mail stored in the storage area (McCormick: column 2, lines 52-53).

c. As per claim 4, Fuisz, in view of McCormick, teaches the method as in claim 3, further comprising allowing the user to update the list to include the source address in the storage area (McCormick: column 2, lines 57-59).

d. As per claims 7, 8, and 9, Fuisz, in view of McCormick, teaches the use of storing, reviewing, and retrieving electronic mail at a server (McCormick: figure 3). The server is a means for implementing claims 2, 3, and 4 respectively, and are thus rejected on the same bases as claims 2, 3, and 4.

e. Claims 12 and 13 are rejected on the same bases as claims 2 and 3 respectively, as claims 12 and 13 discuss an apparatus for implementing the contents of claims 2 and 3.

f. As per claim 14, Fuisz, in view of McCormick, teaches a system to provide e-mail management service comprising:

An e-mail management service server that includes a processor configured to provide a distribution address to a user that the user uses to distribute to at least one of persons and entities the user desires to have contact with (Fuisz: column 5, lines 19-20, wherein the bounce process encompasses the use of a distribution address for use in e-mail forwarding);

A memory to store a list that includes at least one of persons and entities address that the user desires to have contact with, the list further includes at least one forwarding address that is associated with at least one of persons and entities address on the list (Fuisz: column 2, lines 61-62);

An input interface to receive e-mail with a source address, wherein the processor is further configured to compare the source address with the list containing at least one of

persons and entities address, the processor further configured to retrieve the forwarding address if the source address matches at least one of persons and entities address in the list, the memory further configured to store at least one of the source address and the e-mail if sources address does not match at least one of persons and entities address in the list, the memory further configured to store at least one of the source address and the e-mail if source address does not match at least one of the persons and entities address in the list, wherein the processor is configured to allow the user to have access to the stored at least one of the source address and the e-mail (this claim component is rejected on the same bases as claims 1 and 2, as this component is a discussion of the system of claims 1 and 2. Further, the allowance of the user to have access to stored e-mails is implied); The rest of the components of claim 14 are rejected on the same bases as claims 1 and 2 as claim 14 discusses the system of claims 1 and 2.

g. As per claim 15, Fuisz, in view of McCormick, teaches the system as in claim 14, further comprising a network coupled to the server (Fuisz: figure 2; column 8, lines 14-16).

h. As per claim 16, Fuisz, in view of McCormick, teaches the system as in claim 15, where the network is Internet (column 10, lines 23-26).

i. As per claim 17, Fuisz, in view of McCormick, teaches the system as in claim 16, further comprising a plurality of servers coupled to the Internet and in communication with the e-mail management service server (figure 2; column 10, lines 28-29);

j. As per claim 18, Fuisz, in view of McCormick, teaches the system as in claim 16, further comprising at least one computer coupled to a server that is in communication

with the e-mail management service server, the computer includes a graphic user interface (GUI) that is configured to communicate with the e-mail management service server (figures 3 and 4).

k. As per claim 19, Fuisz, in view of McCormick, teaches the system as in claim 15, wherein the network is a wireless network (column 3, lines 64-65; where the use of cellular phones constitutes a wireless network).

l. As per claim 20, Fuisz, in view of McCormick, teaches the system as in claim 19, further comprising at least one wireless device coupled to the wireless network, wherein the wireless network is in communication with the e-mail management service server (column 7, lines 18-29) and the wireless device includes a graphic user interface (GUI) that is configured to communicate with the e-mail management service server (figures 3 and 4, where the GUI is not limited to use in a computer system and can be translated to a wireless network system).

6. Claims 5 and 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuisz in view of McCormick as applied to claims 2 and 7 respectively, and further in view of Ono (U.S. 6,247,076).

a. As per claim 5, Fuisz, in view of McCormick, teaches all of the components of claim 2, but does not specifically teach the deletion of stored electronic mail after an allotted time. Ono teaches the discarding of at least one of a source address and an e-mail stored in a storage area after a pre-determined period of time (column 1, lines 37-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to include

a means for deleting accumulated electronic mail automatically as taught by Fuisz, in the system of McCormick, and further in the system of Ono. The motivation for doing so is because the unwanted electronic mail in the storage folder would begin to accumulate. Since the wanted mail in the storage folder is user-allocated to its appropriate destinations, the remaining mail is then deleted. Also, Fuisz, McCormick and Ono are all from the same field of endeavor of sorting, organizing, and managing electronic mail.

b. Claim 10 is a means for implementing claim 2, and is thus rejected on the same basis as claim 2.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Paul (U.S. 5,999,932) teaches a system and method for filtering unsolicited e-mail messages.
- b. Canale (U.S. 5,619,648) teaches filtering techniques for electronic messages.
- c. Nielsen (U.S. 5,826,022) teaches a method and apparatus for receiving electronic mail.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanim Hossain whose telephone number is 703/305-4003. The examiner can normally be reached on 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 703/305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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